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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/352,949	07/14/1999	KAZUYUKI MURATA	50023-107	2823

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EXAMINER

TRAN, DOUGLAS Q

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 09/23/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/352,949

Applicant(s)

MURATA ET AL.

Examiner

Douglas Q. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/10/02 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The corrected or substitute drawings were received on 7/10/02. These drawings are fig. 1 and 21.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-11 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

For at least claim 1, the specification do not describe the limitation which is addressed in this claim: 1) “input manipulation means ... can request the image server to make a registration with a group”. In contrast, lines 16-20 of page 3 and from line 26 of page 9 to line 5 of page 10 in the specification does not describes the server for making a registration with a group based on requesting from input manipulation means in the each image communication apparatus, but the input manipulation means for making a registration with a group after requesting for sending the group information from the image server; and 2) “input manipulation means ...and can specify one of all the destination group names sent back from the image server” would is not described in the specification because, in lines 20-23 of page 3, the destination group is specified by the digital multifunction apparatus 120, not by the input manipulation.

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However, the Examiner cites the prior arts for rejection based on the limitations of the claims.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Hosotsubo (US Patent No. 6,009,485) and Tabata (US Patent No. 6,198,542 B1).

As to claim 1, Hosotsubo teaches: an image data distribution system wherein the image data will be sent out to the respective members of the destination group specified by the destination information (col. 1, lines 41-44) via a network (21 in fig. 2, col. 6, lines 21-26), the system comprising:

Input manipulation means (24 in fig. 10), provided in each image communication apparatus (i.e., host computer 22 in fig. 2), which can request to make a registration with a group (a user inputs for registering from S11 to S15 in fig. 4, col. 5, lines 40-42 and 66 to col. 6, line 2) and can specify one of all the destination group names (the specified group or groups stored in 25 in fig. 2 and S16 in fig. 4, col. 6, line 55 to col. 7, line 12), and

The image communication apparatus is registered with the specified distribution destination group (col. 5, lines 25-28).

Although Hosotsubo does not explicitly teach means in the server, which sends to a requested apparatus all the distribution destination group names, Hosotsubo teaches a plurality of

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printers 1 connect to a host 22 through a predetermined network 21 (col. 3, lines 56-61).

Therefore, there would be a server in the network for providing the information list of the other connected devices. Also, Hosotsubo teaches the host can exchanges information with a plurality of other apparatus through bi-directional interface (col. 1, lines 46-50) and the printer 1 is suggested as another host computer in the same manner as described to construct a distribution system for an Email or voice mail (i.e., a server for distributing information in the group to a plurality destinations) (col. 6, lines 49-62). Thus, information of the destinations in the group would be obvious to be notified to the host by distribution managing means (i.e., CPU 44 of 1 in fig. 2 and input section 38) of a server (in this case, the printer 1 is represented as a computer server) in LAN network. Furthermore, Tabata teaches a server provides an information group list to the host computer after requesting of the user (Fig. 5, col. 6, lines 31-44 and col. 7, lines 46-50).

It would have been obvious to modify the communication system of Hosotsubo for providing an information group list from a server to the host computer after requesting of the user as taught by Tabata. The suggestion for modifying the system of Hosotsubo can be reasoned by one of ordinary skill in the art as set forth by Tabata because Tabata provides a communication system in which a sever stores and provides any information of the output devices to a host and allows a user easily to keep track information in a group of the output devices and select a designed output devices in the group.

As to claim 2, Tabata teaches that the image communication apparatus is a digital multifunction apparatus (7 in fig. 1)

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As to claim 3, Tabata teaches that the digital multifunction apparatus is provided with image input means for reading a document and sends image data from the image input means to the image server (17 in fig. 3).

As to claim 4, Tabata teaches that the digital multifunction apparatus is provided with storage means for storing image data and sends image data from the storage means to the image server (16 in fig. 3).

As to claim 5, Tabata teaches that the digital multifunction apparatus is provided with facsimile transmit-receive means and sends image data from the facsimile transmit-receive means to the image server (17 in fig. 3).

As to claim 6, Tabata teaches that the digital multifunction apparatus is provided with image output means and prints image data from the image server by the image output means (14 in fig. 3).

As to claim 7, Hosotsubo teaches that the digital multifunction apparatus is personal computer (22 in fig. 2).

As to claim 8, Hosotsubo teaches that the personal computer is provided with document preparation software and sends image data prepared by the document preparation software to the image server (32 in fig. 2).

As to claim 9, Hosotsubo teaches that the personal computer is provided with storage means for storing image data and sends image data from the storage means to the image server (31 in fig. 2).

As to claim 10, Tabata teaches that the personal computer is provided with facsimile transmit-receive means and sends image data from the facsimile transmit-receive means to the image server (17 in fig. 3).

As to claim 11, Tabata teaches that the pc (3 or 4 in fig. 1) prints out image data from the image server by a printing apparatus (5 in fig. 1) connected to the pc directly or via the network (100 in fig. 1).

As to claim 12, the combination of Tabata and Hosotsubo teaches that the method is performed by the apparatus claim 1 as indicated above.

Response to Arguments and Amendment

Applicant's arguments filed 7/10/02 have been fully considered but they are not persuasive.

Applicant asserted in page 4 “ Regarding the Examiner’s concern, Applicants believe that the Examiner that the Examiner has a misunderstanding of the present invention. What is recited in claims 1-11 is consistent with the description in the specification from page 9, line 26 to page 10, line 5, and this description corresponds to the summary (the specification, page 3)“. In reply, the specification, lines 16-20 of page 3 and from line 26 of page 9 to line 5 of page 10, does clearly not describes the server for making a registration with a group based on requesting from input manipulation means in the each image communication apparatus; but the input manipulation means for making a registration with a group after requesting for sending the group information from the image server; and claim 1 including “ input manipulation means ... and can

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specify one of all the destination group names sent back from the image server” would is not described in the specification because, in lines 20-23 of page 3, the destination group is specified by the digital multifunction apparatus 120, not by the input manipulation.

Applicant asserted in page 5 “What claim 1 specifies is that the input manipulation is provided in each image communication apparatus, which corresponds to the digital multifunction apparatus.” In reply, the image communication apparatus in claim 1 is not specified what the apparatus is. The image communication apparatus can be any device communicating with other devices in the network such as either a personal computer, which is claimed in claim 7, or a multifunctional machine (7 in fig. 1 as taught by Tabata).

Applicant asserted in page 5 “In Hosotsubo, only the host 22 (corresponding to the server in the present invention) can register a group. Every operation for registration is done by the host, and no commands are issued from the device that is an image communication apparatus.” In reply, the host 22 connects with a plurality of output devices via the network. Since there is a network such as a LAN or WAN in the distributing system, there would be a server connecting with a plurality of peripheral devices. The input device 22 has the information of a peripheral-devices group that would be provided by the server connected with those peripheral devices. How can the host 22 have the information of a group of connected devices? Because the host exchanges data with the network (col. 1, lines 46-55).

For the above reasons, it is believed that the cited prior art fully discloses the claimed invention and the rejection stand.

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Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas Q. Tran whose telephone number is (703) 305-4857 or E-mail address is Douglas.tran@uspto.gov.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Douglas Q. Tran
Sep. 21, 2002

JOSEPH MANCINI
PRIMARY EXAMINER